

REMARKS

Claims 1-16 are pending. Claims 4-14 and 16 are withdrawn. Claims 1-3 and 15 are rejected.

Claim 1 is now amended. Claims 2-3, and 15 are now canceled without prejudice. Claims 4-14 and 16 are withdrawn. As stated in Applicants' July 28, 2006 Election and Preliminary Amendment, Applicants request that method claims 4-14 and 16 be rejoined upon allowance of composition claims. New dependent claims 17-26 are added, supported at least on page 8, hence Applicants assert there is no new matter.

Applicant respectfully requests considerations of the following arguments.

INFORMATION DISCLOSURE STATEMENT

The Examiner has not considered references "crossed out" in the IDS because it requires a legible copy of each cited foreign patent document/ non-patent literature. Applicants believe they have met this requirement, at least because all the references cited in the IDS are identical to those cited in its parent application, Serial No. 09/688,949, now U.S. Patent No. 6,716,413, which were considered by the Examiner (copies of initialed IDS and Notice of References Cited attached).

For at least these reasons, Applicants request that the Examiner consider the documents that the Examiner "crossed out."

PRIORITY

The Examiner states that "Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under U.S.C. 120 as follows: The parent application number is listed incorrectly on the bibliographic data sheet and is omitted from the oath and declaration. The incorrect parent application number listed on the bibliographic data sheet is 09/688,649." Applicants respectfully disagree.

Applicants respectfully assert that the incorrect parent application number listed on the bibliographic data sheet is a PTO error because 1) the Bibliographic sheet is a PTO document, and 2) the parent application is correctly identified on the Utility Patent Application Transmittal (copy attached) and on the first page of the patent application. In addition, Applicants have properly filed the Declaration as required for a divisional application as required under 37 CFR 1.63 (d)(1).

Applicant respectfully requests that the Examiner correct the bibliographic data sheet and priority to the parent application as identified above.

CLAIM REJECTIONS UNDER 35 U.S.C. §102

Claims 1, 2, and 15 are rejected under 35 U.S.C. §102(b) as anticipated by Licha.

The Examiner states that Licha teaches the "use of 1-(4-sulfobutyl)-2,3,3,3-trimethyl-3H-indolene" as a precursor in the synthesis of diagnostic dyes. Applicants believe that the name of the chemical structure that the Examiner refers to as a precursor is incorrect and that the

Examiner means “1-(4-sulfobutyl)-2,3,3-trimethyl-3H-indolene.” Applicants have amended claim 1 to delete $-(CH_2)_aSO_3T$ and canceled without prejudice claims 2 and 15, and respectfully request that the rejection be withdrawn.

Claims 1, 2, and 15 are rejected under 35 U.S.C. §102(b) as anticipated by Ohno.

The Examiner states that Ohno teaches the use of 1-(4-sulfobutyl)-2,3,3-trimethyl-5-sulfoindolenine in the synthesis of water soluble dyes. Applicants have canceled claims 2 and 15 and have amended claim 1 to delete $-(CH_2)_aSO_3T$ and respectfully request that the reject be withdrawn.

Claims 1, 2, and 15 are rejected under 35 U.S.C. §102(b) as anticipated by Southwick.

The Examiner states that Southwick teaches 5-carboxymethyl-2,3,3-trimethyl-3H-indolium-1-(4'sulfobutyl)-betaine as an intermediate for water-soluble cyanine dyes. Applicants have canceled claims 2 and 15 and have amended claim 1 to delete $-(CH_2)_aSO_3T$. Applicants respectfully requests that the reject be withdrawn.

Claims 1-3 and 15 are rejected under 35 U.S.C. §102(b) as anticipated by Achilefu.

The Examiner states that the compounds in figure 1 or figure 5 of Achilefu have been used as precursors to indocyanine dyes for biomedical applications.



R_1 and R_2 may be H, A is CH_2 or CH_2OCH_2 and R' is $COOH$ or SO_3 . Applicants have canceled claims 2 and 15 and have amended claim 1 to delete $-(CH_2)_aSO_3T$ and $-(CH_2)_dCO_2T$.

Applicants, however, respectfully assert that Achilefu's compound when A is CH_2OCH_2 and R' is $COOH$, which would result in $-CH_2OCH_2COOH$, is not claimed by the Applicants. For at least these reasons, Applicants respectfully assert that Applicants' invention is not anticipated by Achilefu and request that the rejection be withdrawn.

CLAIM REJECTIONS 35 U.S.C. §103

Claims 1-3 and 15 are rejected under 35 U.S.C. §103(a) as obvious over Licha in view of Achilefu. Applicants respectfully disagree.

The Examiner's position is that it would have been obvious to one ordinarily skilled in the art to substitute Y_1 substituent $-(CH_2)_4SO_3^-$ of Licha for the $-CH_2-(CH_2-O-CH_2)_1-CH_2CO_2^-$ substituent of Achilefu. Applicants have deleted $-(CH_2)_aSO_3T$ in claim 1, and canceled claims 2, 3, and 15. Hence, because the primary reference fails the secondary reference cannot support the rejection. Furthermore, Applicants respectfully assert that Achilefu does not disclose $-CH_2-$

$(\text{CH}_2\text{-O-CH}_2)_1\text{-CH}_2\text{CO}_2^-$. As previously analyzed, Achilefu discloses $(\text{-CH}_2\text{OCH}_2)\text{COOH}$. For at least these reasons Applicants respectfully assert that Applicants' invention is not obvious over Licha in view of Achilefu and request that the rejection be withdrawn.

CONCLUSION

Applicants also do not believe any fees are due with this submission. However, if any fees are deemed necessary to complete this communication, the Commissioner is hereby authorized to charge same to Deposit Account No. 23-3000.

The Examiner is invited to contact Applicants' undersigned representative with any questions.

Respectfully submitted,

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